ESTTA Tracking number:

ESTTA657823 02/25/2015

Filing date:

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### **Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

### **Opposer Information**

Name	NOF Metal Coatings North America, Inc.
Granted to Date of previous extension	03/07/2015
Address	275 Industrial Parkway Chardon, OH 44024 UNITED STATES

Attorney informa-	Mark E. Bandy
tion	Rankin, Hill & Clark LLP
	38210 Glenn Avenue
	Willoughby, OH 44094
	UNITED STATES
	bandy@rankinhill.com, kliever@rankinhill.com Phone:216-566-9700

## **Applicant Information**

Application No	86178381	Publication date	01/06/2015
Opposition Filing Date	02/25/2015	Opposition Peri- od Ends	03/07/2015
Applicant	NIPPON STEEL & SUMITOM 6-1, Marunouchi 2-chome, Ch Tokyo, JAPAN		ATION

## Goods/Services Affected by Opposition

Class 006. First Use: 2008/07/18 First Use In Commerce: 2008/07/18
All goods and services in the class are opposed, namely: Galvanized steel plates and sheets

## **Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	NO BONA FIDE USE OF THE MARK AS REQUIRED BY LANHAM ACT SECTION 1(A)

## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4392739	Application Date	03/11/2011
Registration Date	08/27/2013	Foreign Priority Date	NONE

Word Mark	ZINCROKOTE
Design Mark	ZINCROKOTE
Description of Mark	NONE
Goods/Services	Class 006. First use: First Use: 2013/05/02 First Use In Commerce: 2013/05/02 Metal fasteners, namely, nails, bolts, screws, rivets, anchor bolts, washers, nuts, springs, clips and clamps, pins, cotter pins, coiled spring pins, slotted spring pins, studs, pipes, and pipe fittings, all made of ferrous metals, including low and medium carbon steel, alloy steel, atmospheric corrosion-resistant steel, and steel that has been heat-treated, quenched and tempered, for assembly ofmachines, small or large appliances, farm and garden equipment, furniture, toys, pipes, electrical equipment, wooden structures, steel structures, general construction, industrial use, or homeowner use, all treated with corrosion-resistantcoatings

Attachments 85264484#TMSN.png( bytes ) 3543101NoticeOfOpposition.pdf(4919259 bytes )
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## **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/MARK E. BANDY/
Name	Mark E. Bandy
Date	02/25/2015

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:		
Trademark Application Serial No. 86/178,381		
Filed: January 29, 2014		
For the Mark: <b>ZINKOTE</b>		
Published in the Official Gazette on January 6, 2	2015	
Opposer's Reference No. MCI 35431.01		
	)	
NOF Metal Coatings North America, Inc.	)	
Opposer )	)	
V. )	Opposition No	
	)	
Nippon Steel & Sumitomo Metal Corporation	)	
<u>, , , , , , , , , , , , , , , , , , , </u>		
Applicant )		
	)	

#### **NOTICE OF OPPOSITION**

Commissioner for Trademarks P.O. Box 1451 Alexandria, Virginia 22313-1451 Attention: TTAB

NOF Metal Coatings North America, Inc., a Delaware corporation with offices at 275 Industrial Parkway, Chardon, Ohio 44024 (hereinafter "Opposer"), believes it will be damaged by the registration of the word phrase shown in the application bearing S.N. 86/178,381 and hereby opposes registration of said word phrase pursuant to 15 USC §1063 and 37 CFR §2.104. Application S.N. 86/178,381 was published for opposition on January 6, 2015. A request for a 30 day extension of time to oppose registration was filed by Opposer. That request was granted. The current due date to file a Notice of Opposition is March 6, 2015.

1. Upon information and belief, Nippon Steel & Sumitomo Metal Corporation, a corporation of Japan with offices at 6-1, Marunouchi 2-chome, Chiyoda-ku, Tokyo, Japan (hereinafter "Applicant"), filed an application to register ZINKOTE (hereinafter Applicant's

mark), Application S.N. 86/178,381 for "galvanized steel plates and sheets" in International Class 006 on January 29, 2014 (hereinafter "the '381 Application").

- 2. Upon information and belief, the '381 Application is in Standard Character or Typewritten form wherein no claim is made to any stylized format for the word phrase ZINKOTE of the '381 Application.
- 3. Upon information and belief, the '381 Application was filed based on use of the mark and the claimed first use date for the noted goods of "galvanized steel plates and sheets" was July 18, 2008.
- 4. Upon information and belief, Applicant did not use ZINKOTE for the goods recited in the '381 Application prior to January 29, 2014.
- 5. Upon information and belief, Applicant did not use ZINKOTE for the goods recited in the '381 Application prior to January 1, 2013.
- 6. Upon information and belief, Applicant did not use ZINKOTE for the goods recited in the '381 Application prior to January 1, 2012.
- 7. Upon information and belief, Applicant did not use ZINKOTE for the goods recited in the '381 Application prior to January 1, 2011.
- 8. Upon information and belief, Applicant did not use ZINKOTE for the goods recited in the '381 Application prior to July 18, 2008.
- 9. Upon information and belief, Applicant's goods sold under the ZINKOTE mark can be used for any galvanized steel plates and sheets.
- 10. Upon information and belief, Applicant's goods can be provided in any industry and/or field.
- 11. Upon information and belief, Applicant's goods are not restricted to any industry and/or field.
- 12. Upon information and belief, Applicant's mark is printed directly on products or the packaging of products.
- 13. Upon information and belief, Applicant's mark is printed directly on products or the packaging of products sold by others.
- 14. Upon information and belief, Applicant's mark can be or is used in such a way that Applicant's mark would be viewed by a consumer of the goods.

- 15. Upon information and belief, Applicant's mark can be or is used in such a way that Applicant's mark would be viewed by a consumer of the goods and these goods can be in any industry.
- 16. The goods listed in the '381 Application include steel goods treated with corrosion-resistant coatings.
- 17. The goods listed in the '381 Application do not exclude steel goods treated with corrosion-resistant coatings.
- 18. Upon information and belief, Applicant's goods sold under the ZINKOTE mark are viewed in the industries and/or fields of at least one of the following: assembly of machines, small or large appliances, farm and garden equipment, furniture, toys, pipes, electrical equipment, wooden structures, steel structures, general construction, industrial use, and homeowner use.
- 19. Upon information and belief, Applicant's mark is viewed in the industries and/or fields of at least one of the following: assembly of machines, small or large appliances, farm and garden equipment, furniture, toys, pipes, electrical equipment, wooden structures, steel structures, general construction, industrial use, and homeowner use.
- 20. Upon information and belief, Applicant intentionally promotes its ZINKOTE mark to consumers.
- 21. The goods and services listed in the '381 Application include no limitation to the particular type of industry in which the goods are promoted by Applicant.
- 22. Upon information and belief, Applicant uses the word phrase ZINKOTE for the goods recited in the '381 Application.
- 23. Opposer uses its ZINCROKOTE mark to sell metal fasteners, namely, nails, bolts, screws, rivets, anchor bolts, washers, nuts, springs, clips and clamps, pins, cotter pins, coiled spring pins, slotted spring pins, studs, pipes, and pipe fittings, all made of ferrous metals, including low and medium carbon steel, alloy steel, atmospheric corrosion-resistant steel, and steel that has been heat-treated, quenched and tempered, for assembly of machines, small or large appliances, farm and garden equipment, furniture, toys, pipes, electrical equipment, wooden structures, steel structures, general construction, industrial use, or homeowner use, all treated with corrosion-resistant coatings.

- 24. Opposer also uses its ZINCROKOTE mark to promote services of its customers and/or licensees that apply corrosion-resistant coatings to metal parts.
- 25. Opposer is the owner of common law rights in marks with the word phrase ZINCROKOTE.
- 26. Opposer is the owner of Registration No. 4,392,739 for the mark ZINCROKOTE which was filed on March 11, 2011, and which identifies metal fasteners, namely, nails, bolts, screws, rivets, anchor bolts, washers, nuts, springs, clips and clamps, pins, cotter pins, coiled spring pins, slotted spring pins, studs, pipes, and pipe fittings, all made of ferrous metals, including low and medium carbon steel, alloy steel, atmospheric corrosion-resistant steel, and steel that has been heat-treated, quenched and tempered, for assembly of machines, small or large appliances, farm and garden equipment, furniture, toys, pipes, electrical equipment, wooden structures, steel structures, general construction, industrial use, or homeowner use, all treated with corrosion-resistant coatings, in International Class 6 (hereinafter "the '739 Registration"). The mark shown in the '739 Registration has been used since at least as early as May 2, 2013.
- 27. Opposer filed its application for ZINCROKOTE which matured into Registration No. 4,392,739 prior to the filing date of the '381 Application.
- 28. Opposer has used its ZINCROKOTE mark to identify its goods and services prior to the filing date of the '381 Application.
- 29. Opposer's Registration No. 4,392,739 for ZINCROKOTE was registered prior to the filing date of the '381 Application.
- 30. Opposer has made a substantial investment in advertising and promoting the goods and services sold and promoted under Opposer's ZINCROKOTE mark.
- 31. Opposer's extensive and continuous use of ZINCROKOTE has generated substantial revenue and valuable goodwill and reputation.
- 32. Opposer's extensive and continuous use of ZINCROKOTE has made this mark well known in fields using steel fasteners treated with corrosion-resistant coatings.

#### **COUNT I**

Opposer incorporates the allegations of paragraphs 1-32 as is stated herein.

- 33. Opposer has priority trademark and registration rights in Opposer's ZINCROKOTE mark to identify its goods prior to the filing date of the '381 Application.
- 34. Applicant's '381 Application for the word phrase ZINKOTE consists of or comprises a phrase which so resembles Opposer's ZINCROKOTE mark, including the '739 Registration, as to be likely, when used on or in connection with the goods sought to be registered by Applicant to cause confusion, or to cause mistake, or to deceive.
- 35. Applicant's '381 Application for the word phrase ZINKOTE consists of or comprises a phrase which so resembles Opposer's ZINCROKOTE mark including the '739 Registration and other common law marks, as to be likely, when used on or in connection with the goods sought to be registered by Applicant to cause confusion, or to cause mistake, or to deceive.
- 36. The word phrase ZINKOTE as is set forth in the '381 Application, would be improperly viewed as an extension of Opposer's ZINCROKOTE mark, and registration of ZINKOTE to Applicant is therefore likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods, services, or commercial activities by Opposer.
- 37. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged thereby.

#### **COUNT II**

Opposer incorporates the allegations of paragraphs 1-37 as stated herein.

- 38. Applicant seeks registration of ZINKOTE which falsely suggests a connection with the name or identity of the Opposer.
- 39. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged thereby.

#### COUNT III

Opposer incorporates the allegations of paragraphs 1-39 as is stated herein.

- 40. Applicant seeks registration of ZINKOTE on goods and use of this word phrase is merely descriptive of the goods set forth in Applicant's '381 Application.
- 41. Upon information and belief, Applicant filed another application to register ZINKOTE, Application S.N. 79/118,729 for "galvanized steel plates and sheets" in International Class 006 on July 26, 2012 (hereinafter "the '729 Application").
- 42. Upon information and belief, the '729 Application is in standard character or typewritten form wherein no claim is made to any stylized format for the word phrase ZINKOTE of the '729 Application.
- 43. A final refusal to register the ZINKOTE mark in the '729 Application was mailed on or about June 26, 2013 (hereinafter "the final refusal").
- 44. In the final refusal in the '729 Application, registration was refused under Trademark Act Section 2(e)(1) because ZINKOTE merely describes a feature or characteristic of Applicant's goods.
- 45. On or about December 25, 2013, Applicant in the '729 Application filed a Request for Reconsideration after Final Action and submitted an Amendment to Register ZINKOTE under Section 2(f) on grounds that ZINKOTE had acquired distinctiveness through Applicant's alleged "substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement."
- 46. On or about December 25, 2013, Applicant in the '729 Application also presented evidence of use of ZINKOTE. That evidence consisted of (i) a photo of product displaying the word "Zinkote" on a label (attached herewith as Exhibit A), and (ii) a "sales summary sheet" (attached herewith as Exhibit B).
- 47. On or about January 13, 2014, in the '729 Application, an Office Action was issued in which the refusal to register ZINKOTE for "galvanized steel plates and sheets" was continued and maintained. A reason for the refusal to register ZINKOTE was stated in the Office Action as, "[b]ecause the applied-for mark is highly descriptive of a feature of applicant's goods."
- 48. In the Office Action issued on or about January 13, 2014, in the '729 Application, registration was also refused because Applicant's claim of acquired

distinctiveness under Section 2(f) was insufficient. In that Office Action, it was stated that the "evidence does not demonstrate that the applied-for mark has acquired distinctiveness as a source identifier for applicant's goods."

- 49. Applicant expressly abandoned the '729 Application on February 4, 2014.
- 50. The '381 Application seeks to register the same mark ZINKOTE for the same goods of "galvanized steel plates and sheets."
- 51. A refusal to register the ZINKOTE mark in the '381 Application was mailed on or about May 12, 2014 (hereinafter "the second refusal").
- 52. In the second refusal to register the ZINKOTE mark in the '381 Application, registration was refused under Trademark Act Section 2(e)(1) because ZINKOTE merely describes a feature of Applicant's goods.
- 53. On or about November 6, 2014, Applicant in the '381 Application submitted an Amendment to Register ZINKOTE under Section 2(f) on grounds that ZINKOTE had acquired distinctiveness through Applicant's alleged "substantially exclusive and continuous use in commerce . . . for at least the five years immediately before the date of this statement."
- 54. On or about November 6, 2014, Applicant in the '381 Application also presented evidence of use of ZINKOTE. That evidence consisted of (i) a photo of product displaying the word "Zinkote" on a label (attached herewith as Exhibit C), and (ii) a "sales summary sheet" (attached herewith as Exhibit D).
- 55. The photo submitted by Applicant in the '381 Application (Exhibit C) is identical to the photo submitted by Applicant in the '729 Application (Exhibit A).
- 56. The sales summary sheet submitted by Applicant in the '381 Application (Exhibit D) is substantially identical to the sales summary sheet submitted by Applicant in the '729 Application (Exhibit B).
- 57. Because Applicant's claim of acquired distinctiveness under Section 2(f) and supporting evidence submitted in the previous '729 Application was deemed to be insufficient; Applicant's present claim of acquired distinctiveness under Section 2(f) and supporting evidence in the '381 Application is also insufficient.

- 58. Because the noted Amendment under Section 2(f) and supporting evidence in the present '381 Application are insufficient, the second refusal to register ZINKOTE has not properly been remedied or overcome. Thus, ZINKOTE is merely descriptive.
- 59. Applicant's '381 Application should not be granted because Applicant's mark ZINKOTE is merely descriptive, and was previously determined in the prior '729 Application to be descriptive, and on information and belief, Applicant failed to satisfy the requirements of Trademark Act Section 1(a) and related Trademark Rules and Regulations.
- 60. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged thereby.

#### **COUNT IV**

Opposer incorporates the allegations of paragraphs 1-60 as stated herein.

- 61. Applicant claims a first use date for ZINKOTE in the '381 Application of July 18, 2008.
- 62. As evidence of use of ZINKOTE for "galvanized steel plates and sheets," Applicant submitted in the '381 Application, a photo of product displaying the word "Zinkote" on a label (attached herewith as Exhibit E).
- 63. The photo submitted in the '381 Application allegedly evidencing use of the mark ZINKOTE (Exhibit E) is the same photo that was previously presented in the deficient '729 Application (Exhibit A).
- 64. Applicant did not provide any other evidence as to how much and in what manner ZINKOTE is/was advertised in the United States.
- 65. Applicant did not provide any other evidence as to how much capital is spent on advertising ZINKOTE in the United States.
- 66. The submission of the single photo in the '381 Application does not constitute evidence of a bona fide use of the mark ZINKOTE in commerce to properly support registration of ZINKOTE.
- 67. Applicant's '381 Application should not be granted because Applicant's alleged use of the ZINKOTE mark is insufficient to properly support registration of

ZINKOTE, and on information and belief, Applicant failed to satisfy the requirements of Trademark Act Section 1(a) and related Trademark Rules and Regulations.

68. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged thereby.

#### PRAYER FOR RELIEF

WHEREFORE, Opposer prays that application S.N. 86/178,381 be denied, that Applicant be enjoined from obtaining registration of S.N. 86/178,381, that no registration be issued to Applicant and that this opposition be sustained.

A filing fee of \$300.00 is presented herewith. It is respectfully requested that additional fees be charged to Deposit Account No. 180160. Opposer further requests that all correspondence in this matter be addressed to the undersigned.

Respectfully Submitted,

RANKIN, HILL & CLARK LLP

<u>/Mark E. Bandy/</u>

Mark E. Bandy 38210 Glenn Avenue Willoughby, Ohio 44094 (216) 566-9700 (216) 566-9711 E-mail: bandy@rankinhill.com

Attorneys for Opposer

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:	
Trademark Application Serial No. 86/178,381	
Filed: January 29, 2014	
For the Mark: <b>ZINKOTE</b>	
Published in the Official Gazette on January 6, 2	2015
Opposer's Reference No. MCI 35431.01	
,	
NOF Metal Coatings North America, Inc.	
-	
Opposer	
V	Opposition No
Nippon Steel & Sumitomo Metal Corporation	
Applicant	
	)

#### **CERTIFICATE OF SERVICE**

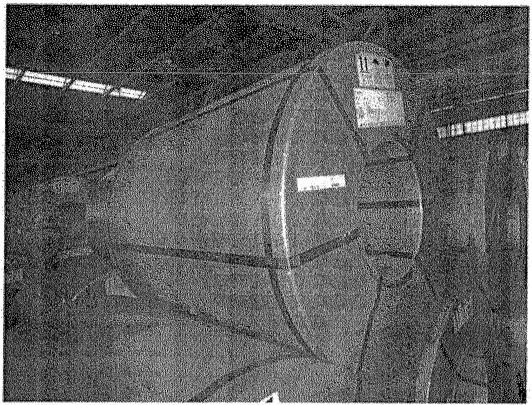
I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was served on:

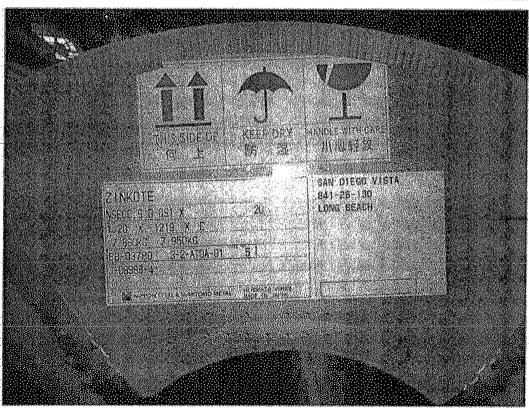
Kaushal Odedra

ODEDRA LAW OFFICE, PLLC 2020 Pennsylvania Avenue, NW, #152 Washington, District of Columbia 20006 United States of America

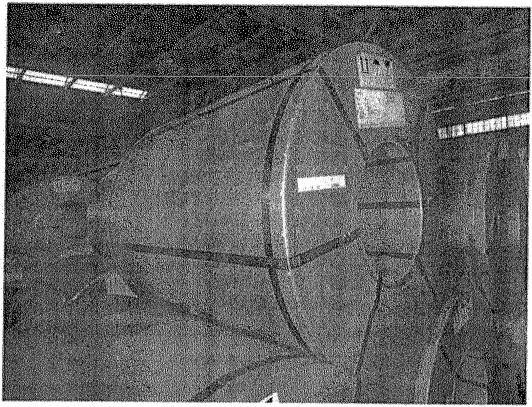
by first class mail, postage prepaid, on February 25, 2015.

Mark E. Bandy Bandy





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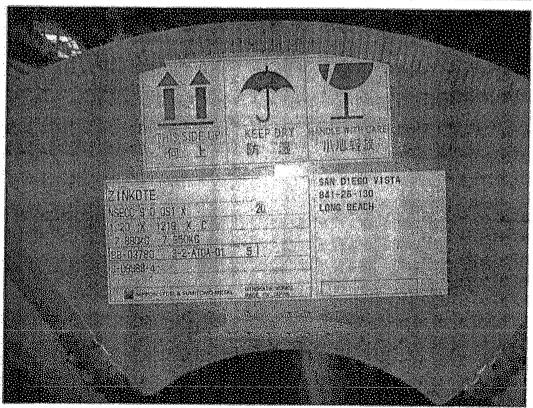
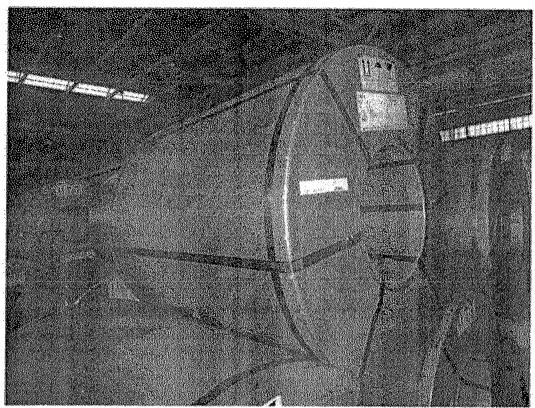


Exhibit C

#### ZINKOTE

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Exhibit D



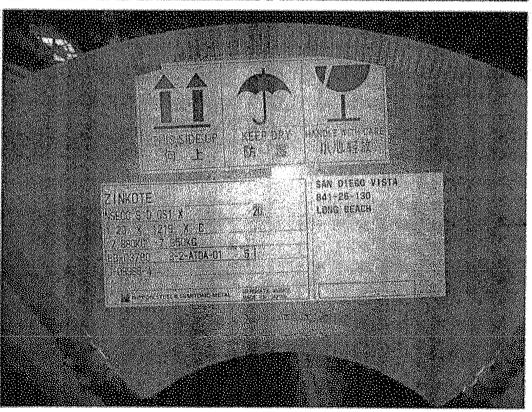


Exhibit E